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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,605	04/14/2004	Atsumasa Mizuno	1086.1199	5079
21171	7590	07/07/2009		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER SENSENG, SHAUN D	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 07/07/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/823,605

**Applicant(s)**

MIZUNO, ATSUMASA

**Examiner**

Shaun Sensenig

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

This action is in response to papers filed on February 27, 2009.

Claims 1, 16, and 17 have been amended.

Claims 2-15 have been cancelled.

Claim 18 has been added.

Claims 1 and 16-17 are pending.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 18** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The material regarding "replacement service", was not present in the original specification.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namiki et al. (Patent No. JP 2002175431 A) (hereafter referred to as Namiki).**

4. In regards to **Claim 1, 17, and 18**, Namiki discloses:

A support method for transition of service providers between portable telephone companies performed by a support server, comprising:

(a) receiving a request for transition from a before-transition portable telephone company to an after-transition portable telephone company while keeping a telephone number, by a transition request reception unit of the support server, from a customer terminal; ([Means for solving problem], "*mediating a contract*" shows the request for a new service, "*acquiring contract information...*" shows contract form previous company; [0053], shows the inputting of the phone number from the previous contract to the phone)

(b) providing information about an after-transition service equivalent to a service contracted before transition to the customer terminal, by an after-transition service

information presentation unit of the support server, the information being based on contents of the service contracted before the transition, the contents being recovered using the telephone number included in the request, from a customer file that stores contents of service correlated with telephone numbers, in the support server and information on contents of the services provided by a service provider that the after-transition portable telephone company can use, registered in a service map file stored in the support server; ([0060] and [0061]), *shows the telephone number being used to retrieve content related to telephone number and services*)

(c) registering contents of an after-transition service correlated with the telephone number in the customer file ([0084], *shows contract information being saved for later reuse (customer file)*)

Namiki discloses all of the above limitations. Namiki does not explicitly disclose the before-transaction and after-transaction contracts being equivalent. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have included the before-transaction and after-transaction contracts being equivalent since it is common for customers to desire equal or better features and services when moving to a new service provider.

**Claim 18** recites substantially similar limitations to Claims 1 and 17. Although it uses different language the material and concepts are the same and therefore rejected using the same art and rationale set forth above.

5. In regards to **Claim 16**, Namiki discloses:

A support method for transition of service providers between portable telephone companies performed by a support server, further comprising:

determining and notifying whether a customer qualifies for a service transition to the customer terminal, by a customer determination unit of the support server, wherein the customer qualifies when customer information recovered from the customer file using the telephone number contained in the request for transition satisfies predetermined criteria. **([0060], shows the telephone number being used to retrieve content related to telephone number and services and [0061], lines 1-4, shows the use of customer information (track record) to determine qualifications)**

### ***Response to Arguments***

1. Applicant's arguments filed February 27, 2009 have been fully considered but they are not persuasive.

2. I. Rejection of Claims under 35 U.S.C. §103

Applicant argues that the Nakimi reference does not include the recovery of contents of service contracted before the transition. The claim recites "the information being based on contents of the service contracted". The information regarding a track record is "based on" the contents of the service contracted. Also, Namiki does refer to "contract information" in general without specifying "track record" in several places throughout the reference ([Claim 8], line 1). Additionally, according to Applicant's specification (Page 27, Step S3) the after transition company can be the same company

as the before transition company ("*...available continuation when the same service company as before transition is used...*")

Additionally Applicant argues that the Namiki reference deals only with mediating new contracts with the same provider. Namiki discusses acquiring contract information from an agency then communicating it to a communication enterprise. ([Claim 1] and [Claim 9, lines 3-6]). If a new contract is created using the acquired contract information, the implication would be that the agency is a different entity than the communication enterprise since the contract was acquired, but the user did not already have a contract with the communication enterprise.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./  
Examiner, Art Unit 3629  
July 2, 2009

/JOHN G. WEISS/  
Supervisory Patent Examiner, Art Unit 3629



